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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,560	07/30/2003	Janusz Jachowicz	FDN-2805	8640

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INTERNATIONAL SPECIALTY PRODUCTS
Attn: William J. Davis, Esq.
Legal Department, Building No. 10
1361 Alps Road
Wayne, NJ 07470

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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06/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/630,560	Applicant(s) JACHOWICZ ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of remarks filed on 2/29/08. Claims 1-49 are pending in the application. All the 102(b) rejections are withdrawn since the publication date of the translated WO documents are not more than year.

Claim Rejections - 35 USC § 112

Claim 49 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

1. This is a written description rejection.

This is a “written description” rejection, rather than an enablement rejection under 35 U.S.C. 112, first paragraph. *Vas-Cath Inc. V. Mahurka*, 19 USPQ2d 1111, states that applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention, for purposes of the “written description” inquiry is “*whatever is now claimed*” (see page 1117).

A review of the language of the claim indicates that these claims are drawn to a genus, *i.e.*, “cosmetic removal agent... heating balm”.

A description of a genus may be achieved by means of a recitation of a representative number of species falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. *Regents of the University of California v. Eli Lilly & Co.*, 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997).

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The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. However, the present claim encompasses numerous species that are not further described. One of skill in the art would not recognize from the disclosure that the applicant was in possession of the genus drawn to skin altering composition using various agents that are claimed in claim 49.

The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder* 736 F.2d 1516, 1521, 222 USPQ 369, 372-373 (Fed. Cir. 1984). Accordingly, it is deemed that the specification fails to provide adequate written description for the genus of various agents in claim 49 and the specification does not reasonably convey to one skilled in the relevant art the inventor(s), at the time the application was filed has possession of the entire scope of the invention drawn to “skin altering composition and which further contains a cosmetic removal agent, a skin stimulating agent, a depilatory agent, an astringent, a skin abrading agent, a wrinkle mollifying agent, a moisturizing agent, a sun blocking agent, a skin soothing or healing balm and mixtures thereof”.

Claim 49 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The metes and bounds of various agents of claim 48 ca not be determined from the disclosure

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-14 and 16-47 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S. Patent 7,223,294 ('294).

See col.11, line 22 through col.12, line 63 for the claimed cationic polymer formed from a, b and c. see the proviso at col.12, which states that if m and n are equal to zero, then p or q is equal to zero. See col.13, ll 4-13 for the species of cationic polymer and these are same as species claimed in claim 8. See col.21, line 54 through col.28, line 28 for the claimed conditioning agent, which is cationic polymer. See col.4, line 36 through col.6, line 45 for anuionic polymer of claim 19, see col.28, line 29 through col.33, line 25 for amphoteric polymers of claim 20 and claims 35-39, see col.14, line 54 through col. 15, line 48 for nonionic polymer of claim 21 see especially col.15, under (4) this is same as claimed copolymers of alkyl acrylates and alkyl methacrylates, see col.15, ll 29-34 for claim 22, which is non-silicone polyurethanes. See col.34, ll 27-48 for claims 25-29 and 42, see col.34, ll 12-19 for claims 30-31, see col.16, line 65 through col.21, line 28 for claims 32-34, see col.34, ll 44-68 for claims 40-41 belonging to non-ionic surfactant, see col33, ll 26-33 for claim 43, see col.34, ll 1-111 for claim 44 and see col34, line 49 through col.35, ll 1-7 for claims 45-47.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U. S. Patents 7,223,294 ('294) and 6,540,791 ('791) and WO 01/41722 (WO document) and 6,984,250 ('250).

Examiner is relying on patent '250, which is English equivalent for WO document.

Patent '294 does not disclose the limitation of claim 15, wherein the conditioning agent is drawn to various silicone compounds and limitation of claim 48, wherein the composition is an anhydrous composition. Patent '791 teaches bleaching compositions (personal care compositions for hair) using conditioning agents. Patent at col.4, line 50 through col. 22, line 41 teaches claimed silicone compounds as conditioning agents. Patent at col.26, ll 29 through col.30, line 32 teaches cationic polymers claimed in claim 14 also as conditioning agents. Thus patent teaches the equivalency between cationic polymers and silicones. Cationic polymers are taught in patent '294. Patent '791 also teaches claimed oxidative hair coloring agent, surfactants, and dyes.

English equivalent of WO document, which is patent '250 teaches bleaching compositions (personal care compositions for hair) and teaches these compositions can be in anhydrous form at col.1, ll 39-41 and col2, ll 33-35.

Accordingly, it would be obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of patent '294 and substitute the conditioning agent, which is cationic polymer of patent '294 with silicones as the conditioning agent in view of equivalency between both the conditioning agents taught by patent '791, expecting silicones to provide conditioning property to hair and prepare the compositions in anhydrous form taught by

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WO document that personal compositions for hair (bleaching) can be an anhydrous form. This is a prima facie case of obviousness.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1615

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